

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellants : Scott P. SCHREER
Serial No. : 10/086,089
Filed : February 28, 2002
Title : SYSTEM AND METHOD FOR ACCESSING....
Examiner : Jason P. SALCE
Group Art Unit : 2421
Confirmation No. : 3357

BRIEF FOR APPELLANT

January 21, 2009

Mail Stop: Patent Appeal (Fee)
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

S I R:

In response to the Notice of Non-Compliant Appeal Brief, please note the corrected Appeal Brief below.

Please note Customer No. 026304 and charge any fees, including any necessary extension fees, to Deposit Account 50-1290; pursuant to 37 C.F.R. 41.37, Applicant for patent herewith appeals to the Board of Patent Appeals from the Examiner's Decision, in the Official Action dated July 24, 2008, finally rejecting claims 1-11. The previously paid Notice of Appeal Fee and Appeal Brief Fee are requested to be applied to this Appeal Brief and accompanying Notice of Appeal.

REAL PARTY IN INTEREST

The real party in interest is Freeplay Music, Inc., a corporation having offices located at 630 Ninth Avenue, New York, New York 10026.

RELATED APPEALS AND INTERFERENCES

An Appeal Brief was filed April 17, 2008 in this matter. The Examiner subsequently reopened prosecution. No other appeals or interferences are known which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 1-11 are pending. No claims are cancelled, withdrawn, or allowed. All claims stand rejected, and are being appealed herewith. The claims on appeal are set out in the Appendix.

STATUS OF AMENDMENTS

No amendment was filed in response to the Final Office Action dated December 27, 2007 (hereinafter "Final Office Action") finally rejecting all pending claims and the Office Action dated July 24, 2008 (hereinafter "July Office Action") reopening prosecution.

SUMMARY OF THE CLAIMED SUBJECT MATTER

Claim 1 (one of two independent claim)

The claimed invention is directed to a method of compensating at least one rights holder responsible for a digital audio recording file for the public performance of the content when the content is included in a public performance.

Under license agreements, songwriters, composers, lyricists and music publishers are legally entitled to receive royalty payments available to copyright owners. For a variety of reasons,

including willful omission, compliance with such agreements is woefully inadequate. Thus, the present invention is directed to ensuring that copyright owners of audio works that are publicly performed via a broadcast over, but not limited to, radio or television to a plurality of audience members are properly compensated for their efforts. Pg. 1, line 10 et al. of the specification as-filed; hereinafter 1:10 et al.

The method claimed in independent claim 1 includes eight (8) steps.

associating an identification with the digital audio recording file to produce an identified digital audio recording file;

The claimed features are described in the specification at least at 12:1 et al., and Fig. 5.

generating an identification record correlating the identification and the digital audio recording file;

The claimed features are described in the specification at least at 12:5 et al., and Fig. 5.

broadcasting the identified digital audio recording file as an audio signal in the public broadcast, . . .

The claimed features are described in the specification at least at 12:9 et al., and Fig. 5.

. . . the public broadcast being made by one of a radio, television, cable, satellite network and internet website, . . .

The claimed features are described in the specification at least at 1:16 et al., 2:3 et al., 9:14 et al.

. . . the public broadcast capable of being remotely receivable simultaneously by a plurality of audience members of the public capable of receiving the audio signal being publicly broadcast;

The claimed features are described in the specification at least at 1:10 et al., 1:14 et al., 1:19 et al., 2:3-5, 7:18-19, 8:16, 9:5, 12:01 et al., and Fig. 5.

receiving by a monitoring station the audio signal being publicly broadcast;

The claimed features are described in the specification at least at 1:10 et al., 1:14 et al., 1:19 et al., 2:3-5, 7:18-19, 8:16, 9:5, 12:9 et al., and Fig. 5.

feeding by said monitoring station the audio signal into monitoring means for detecting the identification;

The claimed features are described in the specification at least at 12:9 et al., and Fig. 5.

storing and correlating by said monitoring station the identification and data solely related to the public broadcast and unrelated to whether even any user constituting the audience members of the public have received the broadcast, based on the identification record as a batch file;

The claimed features are described in the specification at least at 12: 9 et al., and Fig. 5.

importing the batch file into a first database that catalogs public performance, based upon the incidence of the public broadcast and unrelated to the number of actual audience users of the audio signal, and

The claimed features are described in the specification at least at 13:1 et al., and Fig. 5.

using the first database to compensate the at least one rights holder.

The claimed features are described in the specification at least at 7:15 et al., 8:17 et al., and Fig. 5.

The claimed feature also find support the in the applications from which priority is claimed.

Claim 2

Claim 2 adds the additional feature that the identification is embedded in the audio signal as a digital watermark. The claimed features are described in the specification at least at 8:1 et al. This claim also finds support in the '874 application.

Claim 3

Claim 3 adds the additional feature of associating an identification is performed by encoding software. The claimed features are described in the specification at least at 12:9 et al., 12:19 et al. Fig. 5. This claim also finds support in the '874 application.

Claim 4

Claim 4 adds the additional feature that the identification is in the form of a non-audible digital signal that is not rendered inoperable by one or more generations of analog taping and broadcast compressions. The claimed features are described in the specification at least at 8:1 et al., 12:1 et al.. This claim also finds support in the '874 application.

Claim 5

Claim 5 adds the additional features of searching a second digital work library database to match the associated identification with the title of a digital audio work and its associated file information, and importing the title and associated file information from the second digital work library database into the first database. The claimed features are described in the specification at least at 14:14 et al. This claim also finds support in the '874 application.

Claim 6

Claim 6 adds the additional feature of using the associated identification to match the digital audio work's title to the recorded and stored transmission or broadcast related data and printing a digital audio work usage report having both the title of the digital audio work and the transmission and broadcast related data. The claimed features are described in the specification at least at 13:8 et al. This claim also finds support in the '874 application.

Claim 7

Claim 7 adds the additional feature that the digital audio recording file further comprises video or multimedia. The claimed features are described in the specification at least at 1:9 et al. This claim also finds support in the '874 application.

Claim 8

Claim 8 adds the additional feature that the first database is represented in the form of cue sheets. The claimed features are described in the specification at least at 9:14 et al.. This claim also finds support in the '874 application.

Claim 9 (second of two independent claims)

The claimed invention is directed to a method of compensating at least one rights holder responsible for a digital audio recording file for the public performance of the content when the content is included in a public performance.

Under license agreements, songwriters, composers, lyricists and music publishers are legally entitled to receive royalty payments available to copyright owners. For a variety of reasons, including willful omission, compliance with such agreements is woefully inadequate. Thus, the present invention is directed to ensuring that copyright owners of audio works that are publicly performed via a broadcast over, but not limited to, radio or television to a plurality of audience members are properly compensated for their efforts. Pg. 1, line 10 et al. of the specification as filed; hereinafter 1:10 et al.

The method claimed in independent claim 9 includes the following steps.

receiving the publicly broadcast audio recording in a public broadcast as an audio signal,

The claimed features are described in the specification at least at 1:10 et al., 1:14 et al., 1:19 et al., 2:3-5, 7:18-19, 8:16, 9:5, 12:9 et al., and Fig. 5.

the broadcast being made by one of a radio, television, cable, and satellite network and internet website,

The claimed features are described in the specification at least at 1:16 et al., 2:3 et al., 9:14 et al.

the broadcast capable of being remotely receivable simultaneously by a plurality of audience members said receiving being done also by a monitoring station receiving the publicly broadcast signal;

The claimed features are described in the specification at least at 1:10 et al., 1:14 et al., 1:19 et al., 2:3-5, 7:18-19, 8:16, 9:5, 12:9 et al., and Fig. 5.

feeding by said monitoring station the audio signal into a monitoring means to make an identification of the audio recording;

The claimed features are described in the specification at least at 12:9 et al., and Fig. 5.

storing and associating by said monitoring station the identification and data related to the public broadcast based on an identification record as a batch file;

The claimed features are described in the specification at least at 12: 9 et al., and Fig. 5.

importing by said monitoring station the batch file into a first database that catalogs the broadcast and the data related to the broadcast of the audio signal; and

The claimed features are described in the specification at least at 13:1 et al., and Fig. 5.

using by said monitoring station the first database to prepare cue sheets containing the data related solely to the performance when it is broadcast and unrelated to whether there is even any actual use by the receiving audience, to compensate the at least one rights holder.

The claimed features are described in the specification at least at 7:15 et al., 8:17 et al., and Fig. 5.

The claimed feature also find support the in the applications from which priority is claimed.

Claim 10

Claim 10 adds the additional feature of searching a second audio work library database to match the identification with the title of an audio work and its associated file information, and importing the title and associated file information from the second audio work library database into the first database. The claimed features are described in the specification at least at 14:14 et al. This claim also finds support in the '874 application.

Claim 11

Claim 11 adds the additional feature of using the identification to match the audio work's title to the recorded and stored broadcast related data and printing an audio work usage report having both the title of the digital audio work and the broadcast related data. The claimed features are described in the specification at least at 14:14 et al. This claim also finds support in the '874 application.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The present appeal is being filed seeking relief from the rejections and requests resolution

- (a) whether or not claims 1 and 9 are indefinite under 35 U.S.C. §112, second paragraph with respect to *"based on the identification as a batch file;"*
- (b) whether or not claim 1 is unpatentable is unpatentable under 35 U.S.C. §102(e) over U.S. Patent No. 6,574,594 to Pitman;
- (c) whether or not claims 1-7 and 9-11 are unpatentable under 35 U.S.C. §103(a) over U.S. Patent No. 6,253,193 to Ginter in view of U.S. Patent No. 6,385,596 to Wiser; and
- (d) whether or not claims 8 and 9 are unpatentable under 35 U.S.C. §103(a) over Ginter in view of Wiser in further view of non-patent literature BMI "What is a cue sheet." ("Cue Sheet").

No claims are cancelled, withdrawn, or allowed. Thus, the pending and finally rejected claims are claims 1-11 and are being appealed. Although dependent claims 10 and 11 were inadvertently omitted from the last Response by the Applicant, these were never cancelled. Given the exhaustive prosecution on this application with respect to the same references, neither

the Examiner, nor the U.S. Patent & Trademark Office, is disadvantaged by the inadvertent omission of claims 10 and 11. The claims on appeal are set out in the Appendix.

**ARGUMENTS WITH RESPECT TO THE REJECTION UNDER 35 U.S.C. §112,
SECOND PARAGRAPH**

The present appeal is being filed seeking relief from the rejections and requests resolution

(a) whether or not claims 1 and 9 are indefinite under 35 U.S.C. §112, second paragraph with respect to *“based on the identification as a batch file.”*

The alleged limitation is not present in either claim 1 or 9.

Claim 1 recites *“based on the identification record as a batch file.”* Emphasis added. Claim 1, lines 18-19. Claim 1 also includes the limitation of *“generating an identification record correlating the identification and the digital audio recording file,”* which places the limitation of *“based on the identification record as a batch file”* in proper context.

Claim 9 recites *“based on an identification record as a batch file.”* Emphasis added. Claim 9, line 12. That limitation, however, is part of the larger limitation of *“storing and associating by said monitoring station the identification and data related to the public broadcast based on an identification record as a batch file,”* which places the prior limitation in proper context.

It is respectfully contended that the presently claimed invention is definite as required by 35 U.S.C. §112, second paragraph.

**ARGUMENTS WITH RESPECT TO THE REJECTION UNDER 35 U.S.C. §102(E) OF
CLAIM 1**

The present appeal is being filed seeking relief from the rejections and requests resolution

(b) whether or not claim 1 is unpatentable is unpatentable under 35 U.S.C. §102(e) over U.S. Patent No. 6,574,594 to Pitman.

Pitman '594 is cited for the teachings provided at 3:1-7, 4:25-30, 4:30-33, 4:34-50, 5:8-9, 5:11-36, and 5:41-65 within that reference.

Pitman '594 is a continuation-in-part application of U.S. Serial No. 09/803,298, now U.S. Patent No. 6,604,072. Both Pitman '594 and Pitman '072 claim priority to provisional patent application U.S. Serial No. 60/245,799.

A copy of the '799 provisional application, as obtained from PAIR, is enclosed as Appendix C. Therein, the subject matter relied on by the Examiner is not present in the provisional application. Moreover, the subject matter of relied on by the Examiner also is not present in Pitman '072. Thus, the date of the subject matter relied on by the Examiner is July 29, 2001, e.g., the filing date of Pitman '594.

In contrast, the claimed subject matter finds support in and claims priority to Applicant's own U.S. Serial No. 09/736,874 filed December 14, 2000, some seven months prior to the date of the cited art. A copy of the image file wrapper of the '874 application, as obtained from PAIR, is enclosed as Appendix D.

It is respectfully contended that the presently claimed invention is not anticipated by Pitman '594 under 35 U.S.C. 102 (e).

ARGUMENTS WITH RESPECT TO THE REJECTION UNDER 35 U.S.C. §103(A) OF CLAIMS 1-7 AND 9-11 AND ALSO TO THE REJECTION UNDER 35 U.S.C. §103(A) OF CLAIM 8

The present appeal is being filed seeking relief from the rejections and requests resolution

(c) whether or not claims 1-7 and 9-11, are unpatentable under 35 U.S.C. §103(a) over U.S. Patent No. 6,253,193 to Ginter in view of U.S. Patent No. 6,385,596 to Wiser, and

(d) whether or not claims 8 and 9 are unpatentable under 35 U.S.C. §103(a) over Ginter in view of Wiser in further view of non-patent literature BMI “What is a cue sheet.” (“Cue Sheet”).

With regard to claim 1, at essence is whether or not Ginter teaches the following step:

receiving by a monitoring station the audio signal being publicly broadcast;

and,

in claim 9, whether or not Ginter teaches the similar step:

receiving the publicly broadcast audio recording in a public broadcast as an audio signal . . . said receiving being done also by a monitoring station receiving the publicly broadcast signal.

In support that Ginter teaches the claimed steps, the Examiner first cites 3:24-33, which reads:

[Virtual Distribution Environment] can reliably detect and monitor the use of commercial information products. VDE uses a wide variety of different electronic information delivery means: including, for example, digital networks, digital broadcast, and physical storage media such as optical and magnetic disks. VDE can be used by major network providers, hardware manufacturers, owners of electronic information, providers of such information, and clearinghouses that gather usage information regarding, and bill for the use of, electronic information.

In addition, the Examiner cites 147:50-60, which reads as follows:

In this example, record 1302 tracks usage access rights and/or other usage related activities during the present calendar month as well for the five immediately prior calendar months. Corresponding billing and/or billing method 406 may inspect the map, determine usage as related to billing and/or security monitoring for current usage based

on a formula that employs the usage data stored in the record, and updates the wide record to indicate the applicable array elements for which usage occurred or the like.

Applicant respectfully disagrees and submits that in understanding whether or not Ginter teaches this step it is important to determine whether or not Ginter teaches a public broadcast.

Ginter defines a Virtual Distribution Environment as one that “*secures, administers, and audit electronic information use.*” 2:24-27. In the first of his two expert declarations (“Memon 1”, “Memon 2”), Professor Nasir Memon succinctly noted Ginter is essentially interested “*in buying and selling of media.*” Memon 1, ¶ 9. Professor Memon more specifically identified that:

Ginter is concerned with transmitting information from a seller to a specific buyer and controlling the use of the information by the buyer. When Ginter refers to a broadcast, he refers to a specific communication between a seller and a particular user or buyer of the product which is transmitted within the container referred to as a VDE. Ginter is not interested in a public broadcast to multi-user’s. Memon 1, ¶ 9.

Professor Memon goes on to note that in the cited references of Ginter cited by the Examiner on this point (Memon 1, ¶¶13-14, Memon 2, ¶ 7) that

“there is no teaching of monitoring the public broadcast transmitted by a sender regardless of whether any user receives the information or not. All of these broadcast or any reference to the transmission of information relates to the user associated with the sender and essentially monitoring the user’s receiving the information rather than the sender sending the information.” (Emphasis added).

In other words, nothing in Ginter suggest the step of receiving by a monitoring station the audio signal being publicly broadcast. The significant aspect of the presently claimed invention is that the monitoring takes place after the public broadcast is made. Documenting the actual received public broadcast - rather than what may be intended to be broadcast - yields different information and more importantly can be relied on for other purposes, such as compensation of artists.

As such, it is immaterial whether anyone else is tuned in and whether there is even a single user receiving the broadcast, or whether a particular user has requested and downloaded the broadcast, the fact that it has been broadcast is sufficient for the present invention. The presently

claimed invention receives that broadcast after it has been broadcast publicly regardless of whether any other user has requested or received it. However, the physical location of the monitor of the present invention is not significant so long as it is located in order to receive the broadcast.

In the Office Action of Dec. 27, 2007, pg. 2, ¶ 2-3, the Examiner disagrees with the above arguments and notes that *“as the claims are currently written, monitoring could be performed at the user’s location, an intermediate location in the network, or the actual broadcast server.”*

The Examiner states further that it is inherent in a public broadcast that a user requests or receives, e.g., by tuning into, the broadcast.

Applicant respectfully disagrees. A public broadcast and the broadcast of Ginter are different. As Professor Memon had pointed out *“Ginter refers to a specific communication between a seller and a particular user or buyer of the product which is transmitted within the container referred to as a VDE.”* Without a user’s request, there is no broadcast in Ginter. There may be a broadcast to someone else, but, similarly, without the second user’s request the broadcast does not occur.

Thus, regardless where the Ginter device is placed, *“the user’s location, an intermediate location in the network, or the actual broadcast server,”* a user request must be made to a broadcast server in order for the user to receive the broadcast and for Ginter to allegedly monitor it.

In the presently claimed invention, the public broadcast occurs without regard to whether a listener is listening, let alone has made a request for *“the broadcast.”* In other words, a public broadcast is passive to the listener. All listeners may have suffered a power outage and not been able to listen or, conversely, all listeners may have tuned in. It does not matter for the presently claimed invention. The presently claimed invention stands in the shoes of any listener. Whether or not the public broadcast happens based on the broadcaster’s own volition is the only determining factor. Once it does, the presently claimed invention performs the step of

“receiving by a monitoring station the audio signal being publicly broadcast” in order to compensate a rights holder.

In contrast to the presently claimed invention, without a user’s request, there is no broadcast in Ginter. In the presently claimed invention, public broadcast is claimed as being one of a radio, television, cable, satellite network, and internet website and is capable of being remotely receivable simultaneously by a plurality of audience members of the public capable of receiving the audio signal. The broadcast of Ginter does not encompass these aspects.

It is respectfully contended that the presently claimed invention clearly distinguishes over the references.

CONCLUSION

For the foregoing reasons, the final rejection of the claims should be reversed.

FEES

To the extent necessary, applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1290, and please credit any excess fees to said deposit account.

Respectfully submitted,

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CLAIMS APPENDIX

1. A method of compensating at least one rights holder responsible for content of a digital audio recording file for the public performance of the content, the content being included in a public broadcast, the method comprising the steps of:

associating an identification with the digital audio recording file to produce an identified digital audio recording file;

generating an identification record correlating the identification and the digital audio recording file;

broadcasting the identified digital audio recording file as an audio signal in the public broadcast, the public broadcast being made by one of a radio, television, cable, satellite network and internet website, the public broadcast capable of being remotely receivable simultaneously by a plurality of audience members of the public capable of receiving the audio signal being publicly broadcast;

receiving by a monitoring station the audio signal being publicly broadcast;

feeding by said monitoring station the audio signal into monitoring means for detecting the identification;

storing and correlating by said monitoring station the identification and data solely related to the public broadcast and unrelated to whether even any user constituting the audience members of the public have received the broadcast, based on the identification record as a batch file;

importing the batch file into a first database that catalogs public performance, based upon the incidence of the public broadcast and unrelated to the number of actual audience users of the audio signal, and

using the first database to compensate the at least one rights holder.

2. The method of claim 1, wherein the identification is embedded in the audio signal as a digital watermark.

3. The method of claim 1, wherein the step of associating an identification is performed by encoding software.
4. The method of claim 1, wherein the identification is in the form of a non-audible digital signal that is not rendered inoperable by one or more generations of analog taping and broadcast compressions.
5. The method of claim 1, further comprising the steps of searching a second digital work library database to match the associated identification with the title of a digital audio work and its associated file information, and importing the title and associated file information from the second digital work library database into the first database.
6. The method of claim 5, further comprising the step of using the associated identification to match the digital audio work's title to the recorded and stored transmission or broadcast related data and printing a digital audio work usage report having both the title of the digital audio work and the transmission and broadcast related data.
7. The method of claim 1, wherein the digital audio recording file further comprises video or multimedia.
8. The method of claim 1, wherein the first database is represented in the form of cue sheets.
9. A method of compensating at least one rights holder responsible for content of a digital audio recording based solely on performance fees generated by the public broadcast of the content, the method comprising the steps of:
 - receiving the publicly broadcast audio recording in a public broadcast as an audio signal, the broadcast being made by one of a radio, television, cable, and satellite network and internet website, the broadcast capable of being remotely receivable simultaneously by a plurality of audience members said receiving being done also by a monitoring station receiving the publicly broadcast signal;

feeding by said monitoring station the audio signal into a monitoring means to make an identification of the audio recording;

storing and associating by said monitoring station the identification and data related to the public broadcast based on an identification record as a batch file;

importing by said monitoring station the batch file into a first database that catalogs the broadcast and the data related to the broadcast of the audio signal; and

using by said monitoring station the first database to prepare cue sheets containing the data related solely to the performance when it is broadcast and unrelated to whether there is even any actual use by the receiving audience, to compensate the at least one rights holder.

10. The method of claim 9, further comprising the steps of searching a second audio work library database to match the identification with the title of an audio work and its associated file information, and importing the title and associated file information from the second audio work library database into the first database.

11. The method of claim 10, further comprising the step of using the identification to match the audio work's title to the recorded and stored broadcast related data and printing an audio work usage report having both the title of the digital audio work and the broadcast related data.

(ix) Evidence Appendix

Two declarations by Dr. Nasir Memon (“Memon 1” and “Memon 2”) were entered by the Examiner during prosecution of this application. Copies of these as well as Dr. Memon’s Curriculum Vitae are enclosed as Appendices A and B, respectively.

A copy of U.S. Serial No. 60/245/799 to Pitman is enclosed as Appendix C.

A copy of Applicant’s own priority application is enclosed as Appendix D.

(x) Related Proceedings Appendix

No other appeals or interferences are known which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.